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| 22850 7590 10/07/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
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Attachment to Advisory Action

Applicants' amendment filed on 9/18/20099 has been entered Applicants' arguments have been fully considered but are not persuasive for the reasons set forth below.

1. Applicant argues that Mallon et al does not teach an amphoteric dispersant. However, give that Mallon et al teaches a dispersant made from monomers identical to those presently claimed, it is clear that the dispersant disclosed by the reference meet the presently claimed amphoteric dispersant. It is noted that the reference does not refer to the dispersant as non-ionic dispersant but rather that the dispersant comprises non-ionic monomers which are identical to those utilized in the present amphoteric dispersant. Further, it is significant to note that the dispersant can also contain anionic co-monomers such as acrylic acid.

Applicant argues that Jachowicz et al teaches away from using amphoteric dispersant. However, it is noted that Col. 9 Lines 39-44 of the reference clear disclose the use of amphoteric dispersant.

Further Applicant argues that Jachowicz et al is not a relevant reference because the reference disclosed non-polymeric dispersant. However, note that while Jachowicz et al does not disclose all the features of the present claimed invention, the reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely improved stability dues to the amphoteric dispersant, and in combination with the primary reference, discloses the presently claimed invention. If the

secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

Furthermore, while the reference discloses that non-polymeric dispersant are preferred, it is noted that “non-preferred disclosures can be used. A non-preferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.”

In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

2. Applicant argues that Jachowicz discourages one from using polymeric dispersant. However, it is the Examiner’s position that using the polymeric dispersants in Jachowicz would not be proceeding against accepted wisdom in the art given that the reference does not teach away from using polymeric surfactants but merely uses such surfactants as a non-preferred embodiment

As further evidence to support their position, Applicants point to *In re Fulton*. However, it is the Examiner’s position that *Fulton* supports the Examiner’s position given that Jachowicz does not criticize, discredit, or discourage using polymeric surfactants but rather discloses using them in a non-preferred embodiment.

3. Applicant argues that the formulations disclosed by Jachowicz require only one type of polymeric ingredient that has polar character, that the preferred amphoteric surfactant utilized is non-polymeric, and no polymeric in nature. However, it is noted that, “non-preferred disclosures can be used. A non-preferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” In re Nehrenberg, 280 F.2d 161, 126

USPQ 383 (CCPA 1960). Further it is noted that the reference is utilized to teach the compatibility of anionic and cationic components such as cationic or anionic polymers which lead to efficiency and stability of the disclosed compositions.

4. Applicant argues that Lenny does not lead one of ordinary skill in the art to the presently claimed process with respect to specific charge requirements. However, note that while the reference does not disclose all the features of the present claimed invention, the reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely copolymer comprising vinyl formamide which acts as a protective colloid in to stabilize aqueous dispersions, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

5. Applicant argues that Huang is not a relevant reference to the present invention given that the reference does not disclose the process recited in the present claims. However, note that while the reference does not disclose all the features of the present claimed invention, the reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA

1981). Rather this reference teaches a certain concept, namely the use of water soluble cationic polymers and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references. Further it is noted that the reference is used to show that it is known in the arts to use water soluble cationic polymer in various process, i.e. dewatering, paper making, etc which are recited in the present claims.

6. Applicant argues that Bhattacharya is not a relevant reference to the present invention given that the reference does not disclose the process recited in the present claims. However, note that while the reference does not disclose all the features of the present claimed invention, the reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the use of water soluble cationic polymer dispersion in chair or skin cosmetics and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references. Further it is noted that the reference is used to show that it is known in the arts to use water soluble cationic polymer in various process, i.e. dewatering, paper making, etc which are recited in the present claims.

7. Applicant's arguments of unexpected results regarding the stability duration and viscosity of compositions formed by the process recited in the present claims is not found to be convincing for the following reasons:

Comparative examples C1-C8 comprise 80 wt % of VP monomer while inventive examples 8-10 comprise 72 wt %, 80, and 90 wt % of a different monomer, i.e. VFA. Thus the comparison of examples 7-10 to C1-C7 is not a proper side by side comparison due to the different monomers utilized in the inventive and comparative examples. Furthermore, it is noted that comparative examples C1-C6 comprise dispersants that are either cationic or anionic and have a different compositional make-up from the polymeric dispersants utilized in the inventive examples 3-7, i.e. a copolymer of vinylamine-acrylic acid. Of the inventive and comparative examples, the only proper side by side comparison, in terms of constituents such as monomers, dispersant, and cross-linker is the comparison of comparative example C7 to inventive example 7. However, it is noted that the cationic dispersant in comparative example C7 has a molar ratio of vinylamine to acrylic acid of 9:1, while the anionic dispersant utilized in inventive example 7 has a molar ratio of vinylamine to acrylic acid of 1:9. Therefore, given the molar ratios of the two monomers in the comparative (9:1) and the inventive example (1:9) are so vastly different, such it is not clear that the viscosity change in the composition is unexpected. The stability duration obtained by polymerization of cationic monomers in presence of an anionic dispersant is not unexpected given that Jachowicz teaches the criticality of stability of formulations comprising anionic and cationic components.

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